

**REMARKS**

In the Office Action dated August 2, 2005, the Examiner rejected claims 4 and 7-9 as being indefinite under 35 U.S.C. §112, second paragraph. The Examiner rejected claims 1-11 and 45 as being anticipated under 35 U.S.C. §102(b). The Examiner relies on *Kauvar* (U.S. Pat. No. 5,541,070; hereafter “*Kauvar*”) to support this rejection. The Examiner rejected claims 12 and 13 as being obvious under 35 U.S.C. §103(a). The Examiner relies on *Kauvar* and *Natesan* (U.S. Pat. No. 6,015,709; hereafter “*Natesan*”) to support this rejection. Applicant respectfully traverses these rejections.

Dependent claims 7-9 have been amended for clarification. Specifically, claims 7-9 have been amended to state “wherein the array comprises.”

**I. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, Second Paragraph**

Claims 4 and 7-9 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Dependent claims 7-9 have been amended for clarification. Specifically, claims 7-9 have been amended to state “wherein the array comprises.” Support for this amendment of the claims is found in the claims as originally filed.

The Office requests clarification as to what the term “each address” means. The specification provides guidance as to what “each address” means at, for example, page 7, line 31. “This array has 48 addresses (individual spots on the array), which area arranged in an 8 by 12 grid, with eight columns labeled ‘a’ through ‘h’ and twelve rows labeled ‘1’ through ‘12.’” It is clear from the context of claim 4 and the description in the specification

that “each address” is referring to individual spots on the array. The claims are clear and unambiguous as originally written.

One of skill in the art would understand what is meant by “each address” based on the state of the art, what is taught in the specification and what is recited in claim 1. Therefore, applicant respectfully requests the withdrawal of the rejection.

## II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

The Examiner rejected claims 1-11 and 45 as being anticipated under 35 U.S.C. §102(b). The Examiner relies on *Kauvar* (U.S. Pat. No. 5,541,070; hereafter “*Kauvar*”) to support this rejection. A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). The test is the same for a process. Anticipation requires identity of the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt’g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848

F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). Those elements must also be arranged as in the claim. *See, e.g., Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Accordingly, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention.

For at least the reason that *Kauvar* fails to disclose, teach, or suggest at least Applicant's universal protein array comprising a plurality of **substantially pure** target polypeptide samples, as recited in claim 1, Applicant respectfully submits that *Kauvar* does not anticipate Applicant's independent claim 1.

*Kauvar* discloses an array of cells and antibodies, wherein the cells can produce antibodies. *Kauvar* does not teach an array of pure polypeptides. The array of *Kauvar* consists of intact cells, mechanically disrupted cells, any proteins made by the cells, and the antibodies of choice. *Kauvar* teaches using "samples from each well of the 96-well plate, with or without growing murine cells...", col. 28, lines 6-7. Such an array does not comprise **substantially pure** polypeptide samples as recited in the claims.

Accordingly, *Kauvar* does not anticipate claim 1 or claims 2-13 and 45 which depend therefrom. Applicant respectfully requests withdrawal of this rejection.

### III. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejected claims 12 and 13 as being obvious under 35 U.S.C. §103(a). The Examiner relies on *Kauvar* and *Natesan* (U.S. Pat. No. 6,015,709; hereafter “*Natesan*”) to support this rejection. In making a determination of obviousness under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case that (1) the prior art suggests the invention developed, and (2) the prior art indicates that the invention would have a reasonable likelihood of success. *See In re Dow Chem. Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987). In order for a reference to be effective prior art under 35 U.S.C. § 103, it must provide a motivation whereby one of ordinary skill in the art would be led to do that which the applicant has done. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983). The Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Claims 12 and 13 are drawn towards polypeptide samples that can be transcriptional factors, transcriptional activators, or transcriptional coactivators. As claim 13 depends from claim 12 and claim 12 depends from claim 1, claims 12 and 13 possess the limitations of claim 1, including “substantially pure target polypeptide samples.” Neither *Kauvar* nor *Natesan* teach substantially **pure** target polypeptide samples, wherein the polypeptide samples are transcriptional factors, transcriptional activators, or transcriptional coactivators. Additionally, neither *Kauvar* nor *Natesan* teach substantially **pure** target polypeptide samples, wherein the polypeptide samples are those enumerated in claim 12.

A proper *prima facie* case of obviousness has not been presented. The rejections should be withdrawn for at least this reason. If there is no suggestion in either of the cited references relevant to a recited element of the present claims, then the combination of those references cannot render the present invention obvious. As described above in the context of the 35 U.S.C. § 102 rejection, *Kauvar* does not teach an array with substantially pure polypeptides, therefore its combination with *Natesan* can not suggest the claimed array comprising substantially pure polypeptides. Applicant respectfully requests withdrawal of this rejection.

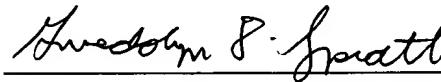
#### IV. CONCLUSION

*Kauvar* does not anticipate any of the pending claims, as this reference fails to show an array with substantially pure polypeptides. The combination of *Kauvar* and *Natesan* does not render obvious the present claims because it fails to suggest an array comprising substantially pure polypeptides. Applicant respectfully requests allowance of all the outstanding claims. The Examiner is invited and encouraged to contact directly the undersigned if such contact may enhance the efficient prosecution of this application to issue.

ATTORNEY DOCKET NO. 14014.0432U2  
APPLICATION NO. 09/936,005

No fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency or to credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

  
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Gwendolyn D. Spratt, Registration No. 36,016

NEEDLE & ROSENBERG, P.C.  
Customer Number 23859  
(678) 420-9300 (Telephone)  
(678) 420-9301 (Facsimile)

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Gwendolyn D. Spratt, Registration No. 36,016



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